

## REMARKS

### I. INTRODUCTION

Claims 1-14 and 16-22 are pending in the present application.

Claims 1-2, 6-8, 16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. 09325165 to Oji ("Oji") in view of U.S. Patent No. 6,597,083 to Gallmeyer et al. ("Gallmeyer"). Claims 5, 9, 11-12, 18, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji in view of Gallmeyer as applied to claims 1-2, 6-8, 16 and 19, and further in view of Japanese Patent No. 03122544 to Shimizu et al. ("Shimizu"). Claims 3, 4 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji in view of Gallmeyer as applied to claims 1-2, 6-8, 16 and 19, and further in view of U.S. Patent No. 6,184,504 to Cardella ("Cardella"). Claims 10, 13-14 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji, Gallmeyer and Shimizu as applied to claims 5, 9, 11-12, 18, 20 and 22, and further in view of U.S. Patent No. 6,297,579 to Martin et al. ("Martin").

### II. FINALITY OF OFFICE ACTION

Applicant respectfully requests that the finality of the pending Office Action be withdrawn since it was based on a new ground of rejection. The M.P.E.P. at section 706.07(a) states that a second or subsequent action on the merits shall be final -- except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendments of the claims nor based on information submitted in an information disclosure statement.

It is respectfully submitted that the new ground of rejection was not necessitated by Applicant's amendments nor based on information submitted in an information disclosure statement. The present Office action asserts on page 8 that "since the amendment filed by Applicant in Paper No. 7 changes

in the scope of independent claim 1, by adding the features recited previously in claim 15, and moreover changes the limitations included in the dependent claims, it is considered that the amendment filed by Applicant on May 8, 2003 necessitated the new ground(s) of rejection presented in this Office action." Applicant respectfully disagrees. In the amendment of May 5, 2003, claims 1, 5, 6, 7, 11, and 16 were amended to better clarify the subject matter claimed in response to a §112 rejection, and the features that were added to independent claim 1 were already present in the application in dependent form. No new matter was added and no new issues were raised. In particular, the features previously added to independent claim 1 were like those of canceled claim 15. Thus, these features were merely placed in independent form and did not necessitate the new ground of rejection. Accordingly, the finality of the present office action is not sustainable and should be withdrawn.

### **III. REJECTION OF CLAIMS 1-2, 6-8, 16 and 19 UNDER 35 U.S.C. § 103**

Claims 1-2, 6-8, 16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji in view of Gallmeyer.

Applicant respectfully notes that the filing date of December 19, 2001 for U.S. Application No. 10/025,400, from which Gallmeyer issued, is after the U.S. filing date of October 24, 2001 for the present application. Accordingly, it is respectfully submitted that Gallmeyer is not a valid prior art reference against the present application. Furthermore, since Oji clearly does not teach or suggest all of the limitations of claim 1 (as acknowledged by the Examiner), it is respectfully submitted that claim 1 is not rendered obvious by the combination of references applied by the Examiner.

Claims 2, 6-8, 16, and 19 depend, either directly or indirectly, from claim 1 and therefore include all of the limitations of claim 1. Accordingly, these claims are likewise not rendered obvious for at least the same reasons

claim 1 is not rendered obvious. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of the foregoing, it is respectfully submitted that claims 1-2, 6-8, 16 and 19 are allowable for at least these reasons. Withdrawal of this rejection is therefore respectfully requested.

**IV. REJECTION OF CLAIMS 5, 9, 11-12,  
18, 20 and 22 UNDER 35 U.S.C. § 103(a)**

Claims 5, 9, 11-12, 18, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Oji in view of Gallmeyer as applied to claims 1-2, 6-8, 16 and 19, and further in view of Shimizu.

For the reasons stated above, it is respectfully submitted that Gallmeyer is not a valid prior art reference against the present application. Accordingly, even if it were proper to combine the remaining references as suggested (which is not conceded), Shimizu does not cure the critical deficiencies of Oji with respect to claim 1, from which claims 5, 9, 11-12, 18 and 20 ultimately depend. Indeed, the Office Action does not allege that they do. Moreover, the Office Action assertions that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine these references "in order to increase the accuracy of the measurement data" or "to allow a more accurate determination of the change in dimensions of the material by capturing and recording a two-dimensional image of the material" is improper since such assertions are merely suggestions on the part of the Examiner and lack any supporting basis in either Oji or Shimizu. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure). Accordingly, the required motivation or suggestion to combine these references is lacking.

In view of the foregoing, it is therefore respectfully submitted that claims 5, 9, 11-12, 18, 20 and 22 are allowable for at least these reasons. Withdrawal of this rejection is therefore respectfully requested.

**V. REJECTION OF CLAIMS 3, 4,  
and 17 UNDER 35 U.S.C. § 103(a)**

Claims 3, 4 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji in view of Gallmeyer as applied to claims 1-2, 6-8, 16 and 19, and further in view of Cardella.

For the reasons stated above, it is respectfully submitted that Gallmeyer is not a valid prior art reference against the present application. Accordingly, even if it were proper to combine the remaining references as suggested (which is not conceded), Cardella does not cure the critical deficiencies of Oji with respect to claim 1, from which claims 3, 4 and 17 depend. Indeed, the Office Action does not allege that it does. Accordingly, it is respectfully submitted that claims 5, 9, 11-12, 18, 20 and 22 are allowable for at least the same reasons that claim 1 is allowable. Withdrawal of this rejection is therefore respectfully requested.

**VI. REJECTION OF CLAIMS 10, 13-14,  
and 21 UNDER 35 U.S.C. § 103(a)**

Claims 10, 13-14 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oji, Gallmeyer and Shimizu as applied to claims 5, 9, 11-12, 18, 20 and 22, and further in view of Martin.

For the reasons stated above, it is respectfully submitted that Gallmeyer is not a valid prior art reference against the present application. Accordingly, even if it were proper to combine the remaining references as suggested (which is not conceded), Martin and Shimizu do not cure the critical deficiencies of Oji with respect to claim 1, from which claims 10, 13-14 and 21 ultimately depend. Indeed, the Office Action

does not allege that they do. Accordingly, it is respectfully submitted that claims 10, 13-14 and 21 are allowable for at least the same reasons that claim 1 is allowable. Withdrawal of this rejection is therefore respectfully requested.

**VII. CONCLUSION**

It is respectfully submitted that all pending claims are in condition for allowance. Passage to issuance is, therefore, requested.

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Respectfully submitted,

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